

HAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

#21

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GALLEON S.A., :
BACARDI-MARTINI U.S.A., INC. :
and BACARDI & COMPANY LIMITED, : Cancellation No. 24,108

Petitioners :

v. :

HAVANA CLUB HOLDING, S.A. and :
HAVANA RUM & LIQUORS, S.A. :
d/b/a H.R.L., S.A. :

held 30

Respondents. :

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MOTION FOR EXTENSION OF TIME
FOR PETITIONERS TO FILE A RESPONSE TO RESPONDENTS' MOTION FOR
SUMMARY JUDGMENT DISMISSING THE PETITION AND FOR OTHER RELIEF

Petitioners respectfully move in the above-captioned proceeding that the period of time in which petitioners may file opposing papers or otherwise respond to Respondents' Motion For Summary Judgment Dismissing The Petition And For Other Relief (the "Summary Judgment Motion") be extended from the present deadline of December 9th (the 7th is a Saturday) up to and including January 6, 1997.

Respondents' Summary Judgment Motion was served on Petitioners, by mail, on October 18, 1996. Therefore, Petitioners' response to the Summary Judgment Motion was

originally due no later than November 7, 1996. On October 25, 1996, Petitioners requested and were granted a thirty (30) day extension of time through and including December 9, 1996. Petitioners counsel thereafter requested an additional two-week extension through and including December 23, 1996.¹ Respondents' position on the extension is as appears in a letter dated November 27, 1996, from Caroline Rule, Esq., one of Respondents' attorneys, a copy of which is attached as Exhibit A.

A motion to extend time may be granted by the Trademark Trial and Appeal Board for "cause". § 509, Trademark Trial and Appeal Board Manual of Procedure. In the papers supporting their Summary Judgment Motion, Respondents rely extensively on evidence introduced by way of a summary judgment motion in a prior proceeding in which there was no discovery and on affidavit testimony that is uniquely inaccessible to Petitioners. These include twenty-four (24) Declarations, thirteen (13) of which have been sworn to by residents and citizens of Cuba (Declaration Nos. 1, 2, 3, 4, 5, 6, 8, 9, 10, 11, 12, and 20.) Since Cuba is a closed society and business travel there is greatly circumscribed pursuant to regulations issued by the Department of the Treasury, the process of compiling evidence in support of answering papers and declarations is exceedingly difficult and is taking considerably more time than in a run of the mill proceeding.

The difficulty of Petitioners position is further underscored by the nature of

¹Petitioners have concluded the additional time is necessary because of the Hanukkah, Christmas, and New Year's holiday periods and because of the PTO's policy regarding extensions. The additional time assures that no further requests will be forthcoming.

Respondents' other submissions in support of the Summary Judgment Motion. The original purported agreements of sale and assignment of the HAVANA CLUB mark are by no means easily accessible to Petitioners. Rather they are maintained in the archives of the Department of Registry and Notary in Havana, Cuba, (Decl. 6, ¶ 7), as is the original of the purported license from Havana Club Holding, S.A. to Havana Club International, S.A. (Decl. 11, ¶ 7). Through "translations" (Decl. 2, Exh. F; Decl. 3, Exh. A; Decl. 7; Decl. 11, Exh. B; Decl. 22, Ex. A) and a so-called certification of a possible party-in-interest (Decl. 6, Exhs. A & B), Respondents nonetheless rely heavily on the aforesaid agreements.

In addition to the foregoing, Respondents rely extensively on other documents of foreign origin, specifically:

Cuban Law 890 and 934 and Resolution No. 234 (Decl. 22, Exhs. A-C);

Periodicals published in Cuba (Decl. 21, Exhs. A-C);

A tour-book published by Cuba's National Institute of Tourism (Decl. 21, Exh. D);

Advertisements and promotional materials purportedly appearing in various publications "directed to tourists in Cuba" (Decl. 21, Exhs. E-M);

Certifications, in Spanish, of Doctora Felicitas Regla Lopez Sotolanga, a notary of the Special Notary of the Ministry of Justice of Cuba, which purportedly relate to the sale and assignment agreement between Havana Rum Liquors, S.A. and Havana Club Holding, S.A. (Decl. 6, Exhs. A & B);

Advertisements from France, Italy, Great Britain, Germany, Mexico, Canada, Japan, Spain, Sweden, Austria, dating from 1972 through 1992 (Decl. 8, Exh. A); and

Trademark registrations from: Spain, Germany, Great Britain and Northern Ireland, France, Denmark, Austria, Sweden, Hungary, Finland, Canada, Mexico, Chile, Argentina, Peru Bolivia, Panama, and Costa Rico. None of the foregoing appears to evidence a certification as to current status. The dates of issuance of these documents seem to range from 1976 through 1992. Moreover, none of the foregoing has been translated into English, with each being offered solely in the language of the country of origin.

Respondents further rely on non-contemporaneous information and/or third party materials, including:

A declaration as to purported sales and revenues from 1972 to 1988 (Decl. 10);

Correspondence from 1977, 1978 and 1979 (Decl. 2, Exhs. A & B; Decl. 10, Exh. A); and

Numerous third party publications and releases (Decl. 2, Exhs. C & D; Decl. 16, Exhs. A through F; Decl. 21, Exhs. E-V; & Decl. 24, Exhs. A-D).

Given the nature of Respondents' supporting materials, both in documentary and testimony form, a proper response to the Summary Judgment Motion necessitates significant time and travel. Furthermore, as appears from the affidavit of William R. Golden, Jr., the two primary counsel for Petitioners in this proceeding have been prevented from devoting as much time to the HAVANA CLUB matter as they originally planned. Mr. Golden is obliged to argue a motion before the Federal Circuit this week, which had not been scheduled until after service of the summary judgment papers and has also been ill with a respiratory ailment. Margaret Ferguson, another of Petitioners counsel, was unexpectedly out of the office from November 9th through November 18th due to the sudden serious illness of her

infant son which required his hospitalization. These unforeseen events took away precious time from an already tight timeframe for responding to the Summary Judgment Motion.

Moreover, for all practical purposes, given the holidays of Hanukkah, Christmas and New Year's, the specific requested extension through and including January 6, 1997 is by no means an excessive amount of time. Aside from the obvious constraints of the holiday season, it is a time of year when many businesses slow down or even close completely, thereby further hindering the process of information-gathering.

Finally, Petitioners make reference to the policy of the Trademark Trial and Appeal Board which encourages parties to proceedings to not seek extensions of time of less than thirty (30) days.

For all of the foregoing reasons, Petitioners respectfully request that its instant Motion be granted.

Dated: New York, New York
December 3, 1996

KELLEY DRYE & WARREN
Attorneys for Petitioners
GALLEON S.A.,
BACARDI-MARTINI U.S.A., INC. and
BACARDI & COMPANY LIMITED

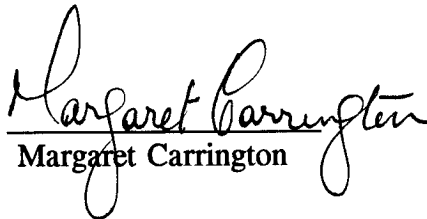
By: 

William R. Golden, Jr.
Margaret Ferguson
101 Park Avenue
New York, New York 10178
(212) 808-7800

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing MOTION FOR EXTENSION OF TIME FOR PETITIONERS TO FILE A RESPONSE TO RESPONDENTS' MOTION FOR SUMMARY JUDGEMENT DISMISSING THE PETITION AND FOR OTHER RELIEF has been served upon Respondents' attorneys, Michael Krinsky at Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., at 740 Broadway, 5th Floor, New York, New York 10003 the address designated by said attorney for that purpose by depositing a true copy thereof with the United States Postal Service as first-class mail on December 3, 1996.

Dated: December 3, 1996


Margaret Carrington

CERTIFICATE OF MAILING

Express Mail, Mailing No. EG179584431US

Date of Deposit December 3, 1996

The undersigned hereby certifies that the foregoing paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Box TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.


Margaret Carrington

RABINOWITZ, BOUDIN, STANDARD, KRINSKY & LIEBERMAN, P.C.
ATTORNEYS AT LAW
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NEW YORK, N.Y. 10003-9518

TELEPHONE (212) 254-1111

CABLE "RABOUDIN, N.Y." TELEX 225028

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LEONARD B. BOUDIN (1912-1989)
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THOMAS C. VILES
LAURIE EDELSTEIN
CAROLINE RULE
MICHAEL LUDWIG
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COUNSEL
VICTOR RABINOWITZ
MICHAEL B. STANDARD
LEONARD I. WEINGLASS
ELLEN J. WINNER
DEBRA EVENSON
TERRY GROSS

November 27, 1996

*ADMITTED IN PENNSYLVANIA AND
NEW JERSEY ONLY

VIA FAX 914-244-0722

Margaret Ferguson
Kelley Drye & Warren
101 Park Avenue
New York, New York 10178

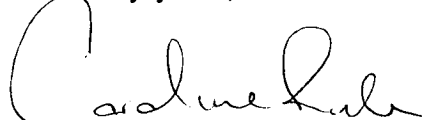
Re: Galleon, S.A., et al. v. Havana Club Holding, S.A. et ano.

Dear Ms. Ferguson:

I discussed with Michael Krinsky your request for our agreement to a two-week extension of time to file your response to Havana Club Holding, S.A.'s and Havana Club International, S.A.'s motion for summary judgment in the above-referenced matter. We cannot consent to an extension, but will not oppose an application made by you for an extension until December 16, 1996, provided that we receive your papers, delivered by hand if necessary, by 9:30 a.m. on December 16, and provided that you agree not to oppose on timeliness grounds our filing reply papers if we so file before the end of January, 1996.

In any request you may make to the Trademark Trial and Appeal Board for an extension of time, whether until December 16 or otherwise, we authorize you to attach a copy of this letter to your request, but to make no other representations concerning our position on this issue.

Sincerely yours,


Caroline Rule



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GALLEON S.A.,
BACARDI-MARTINI U.S.A., INC., and
BACARDI & COMPANY LIMITED,

Petitioners,

- against -

HAVANA CLUB HOLDING, S.A., and
HAVANA RUM & LIQUORS, S.A. d/b/a
H.R.L., S.A.,

Respondents.

Registration No. 1,031,651

Cancellation No.: 24,108

AFFIDAVIT OF WILLIAM R. GOLDEN, JR.

William R. Golden, Jr. being duly sworn, deposes and says;

1. I am a member of the Bar of the State of New York and am the attorney with overall responsibility for representing Petitioners in the HAVANA CLUB cancellation proceeding. I make this affidavit in support of Petitioners' motion for a further extension of time up to and including January 6, 1997 to file opposing papers or otherwise respond to Respondents' summary judgment motion.

2. The request for an extension is made in good faith, and not for purposes of delay.

3. The facts in dispute here largely lay within the knowledge of present and former employees of respondents and the situs of many of the witnesses, as shown by respondents' own papers which contain thirteen (13) Cuban-based declarations, is Cuba.

4. My understanding is that it is unlawful to travel to Cuba for a business or legal purpose without a license from the Department of Treasury, Office of Foreign Asset Control. More germanely, Cuba, under the Castro regime, is virtually a closed society, so as a practical matter, Cuban residents are not free to cooperate or give affidavits that could be perceived to be adverse to the interests of the existing Castro regime or the business entities in which it participates.

5. Given this constraint, it is a time-consuming process to gather facts and materials in opposition to the summary judgment motion, much of which will have to come from Europe and expatriate Cubans.

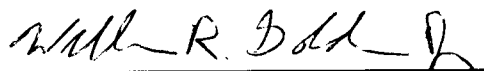
6. While our efforts to date have proceeded full bore, more time is needed to bring them to fruition, particularly at this season of the year when schedules are difficult to coordinate due to business closings over the holidays and travel difficulties.

7. Moreover, several unexpected obstacles have cropped up, further adding to the need for an extension. After the present summary judgment motion was made, the Federal Circuit set down for December 4, oral argument on an appeal in which I am the attorney of record. This will require me to travel to Washington D.C. I have also been hindered over the last two to three weeks by a respiratory condition that turned into a sinus infection for which I am receiving antibiotics. This condition rendered flying inadvisable and prevented me from working over Thanksgiving. In early November, Ms. Ferguson, the

primary lawyer assisting me on this motion was forced to miss a substantial amount of time because of the illness of her youngest child who was unexpectedly hospitalized.

8. We have granted Respondents reasonable extensions of time in the past and will continue to do so in the future as that is my customary practice in TTAB proceedings. We will also serve Respondents by hand in the future and expect they will do the same.

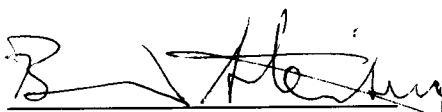
9. No further requests for an extension of time on this motion are anticipated.


William R. Golden, Jr.

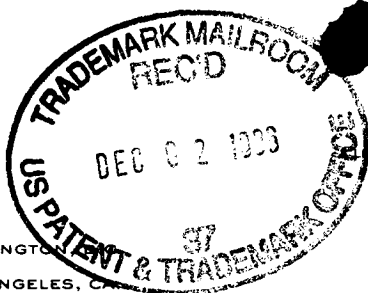
ACKNOWLEDGMENT

STATE OF NEW YORK)
 : SS:.
COUNTY OF NEW YORK)

On the 2nd day of December, 1996, before me personally came William R. Golden, Jr., to me known, to be the individual described in and who executed the foregoing instrument and acknowledged that he executed the same.


Notary Public

BENNET STEINBERG
A Notary Public of New York
No 02ST5048838
Qualified in New York
Commission Expires 09/05/97



KELLEY DRYE & WARREN LLP

LIMITED LIABILITY PARTNERSHIP INCLUDING PROFESSIONAL ASSOCIATIONS

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PARSIPPANY, N.J.

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December 3, 1996

Box TTAB NO-FEE
Assistant Commissioner for
Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: GALLEON S.A., BACARDI-MARTINI U.S.A., INC.
and BACARDI & COMPANY LIMITED v. HAVANA CLUB
HOLDING, S.A. and HAVANA RUM & LIQUORS, S.A.
d/b/a H.R.L., S.A. -- Cancellation No. 24,108

Dear Sir or Madam:

On behalf of Petitioners, Galleon, S.A., Bacardi-Martini U.S.A, Inc. and Bacardi & Company Limited, we enclose a Motion for Extension of Time for Petitioners to File a Response to Respondents' Motion for Summary Judgment Dismissing the Petition and for Other Relief.

Please acknowledge receipt of same on the enclosed postcard.

Very truly yours,


Margaret Ferguson

MF:mc
Enclosures



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1124

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GALLEON S.A.,
BACARDI-MARTINI U.S.A., INC., and
BACARDI & COMPANY LIMITED,

Petitioners,

-against-

HAVANA CLUB HOLDING, S.A. and
HAVANA RUM & LIQUORS, S.A. d/b/a
H.R.L., S.A.,

Respondents.

Registration No. 1,031,651

x
: Cancellation No. 24,108

#180

DECLARATION OF MARIA DEL CARMEN ABARRATEGUI GOICOLEA

I, Maria del Carmen Abarrategui Goicolea, declare under penalty of perjury under the laws of the United States of America that the following is true and correct:

1. I am a citizen of Cuba, and I reside in Havana, Cuba. I make this declaration to supplement my two prior declarations in opposition to the petition pending in the United States Patent and Trademark Office to cancel Havana Club Holdings, S.A.'s United States registration of the trademark HAVANA CLUB. I assume familiarity with, and incorporate herein by reference, my prior declarations. I make this supplemental declaration on the basis of my personal knowledge of the facts stated therein.

2. Since 1993, I have been the Commercial Director of Havana Club International, S.A., a corporation organized under the laws of the Republic of Cuba which is licensed to distribute HAVANA CLUB rum. From 1975 until 1980 I was the Director of Market Research at Cubaexport, the company which owned the business of HAVANA CLUB rum including the trademark HAVANA CLUB under which HAVANA CLUB rum was sold. From 1980 until 1993, I was Vice President of Cubaexport and directed its Department of Marketing and Sales. In my capacity first as director of market research and later as Vice President of Cubaexport, and then as Commercial Director of Havana Club International, S.A., I obtained personal knowledge of the promotion, sales and distribution of HAVANA CLUB rum by Cubaexport and Havana Club International, S.A., a corporation which specializes in the sale and distribution of HAVANA CLUB rum.

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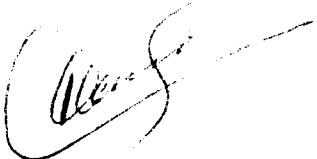
3. Since 1972, Cubaexport, Havana Rum & Liquors, S.A. and Havana Club International, S.A., each have engaged in advertising and promotional activities to promote increased sales of HAVANA CLUB rum to United States visitors in Cuba, along with other foreign tourists, both for its import into the United States and its consumption in Cuba. Each of these companies has been aware that since 1977, United States trade regulations have permitted United States visitors to Cuba to purchase \$100 worth of consumer goods in Cuba for importation into the United States as accompanying baggage upon their return exclusively for their personal consumption or for their use as gifts. Through advertising and promotional activities, each of the companies has sought to take as full advantage as possible of this opportunity to export HAVANA CLUB rum to the United States.

4. To these ends, each of the companies since 1972 regularly have carried out a special program of advertising and promotion directed at foreign visitors and tourists in Cuba, including those from the United States, using all media available in Cuba as well as the organization of special promotional activities. These efforts are outlined below. They have proved effective, as a substantial quantity of rum has been sold to United States visitors for importation to the United States.

5. During the noted period, Cubaexport and Havana Club International, S.A. have inserted advertisements in the following publications which are or have been sold to primarily to visitors and tourists: Cuba Internacional, Prisma, International Granma, Sol y Son, Opciones, and other special publications which are not published on a regular basis. With the exception of Opciones and the special publications, all are regularly published in both English and Spanish.

6. During the noted period, Cubaexport and Havana Club International, S.A. have placed advertisements of HAVANA CLUB rum on outdoor billboards located in places frequented by visitors and tourists in Cuba, including: Via Monumental, Playas del Este, the entrance to Varadero Beach, Varadero Airport, Rancho Boyeros Avenue, Havana Jose Marti International Airport, Huguin Airport and Camaguey Airport.

7. During the noted period, Cubaexport and Havana Club International, S.A. regularly have put in place a broad campaign to promote HAVANA CLUB rum in tourists centers such as hotels, restaurants, discoteques and bars by distributing promotional articles which have the HAVANA CLUB mark and which personalize the service such as: stirrers, coasters, ice buckets, glasses, ashtrays, dispensers, luminated displays, posters, recipe brochures and others. In conjunction with these tourist facilities, Cubaexport and Havana Club International, S.A. have sponsored promotional activities such as parties, special offerings and other activities which contribute to the identification of the mark HAVANA CLUB.



8. During the noted period, Cubaexport and Havana Club International, S.A. have taken advantage of the substantial growth in tourism to Cuba by establishing agreements with the principle tourism enterprises to carry out promotional activities directed at tourists such as: developing specific points of sale, undertaking activities such as contests, raffles, happy hours and cocktail-making classes using HAVANA CLUB rum, Tourist Carnivals, Welcome Cocktails in the airport and in hotels and other public relations activities.

9. Since the 1980s, Cubaexport and Havana Club International, S.A. have provided promotional support to innumerable international sports, cultural and scientific events, both in Cuba and abroad, which provided other avenues for increasing the visibility and awareness of HAVANA CLUB rum.

10. Since 1973, HAVANA CLUB rum has been sold in significant quantities in the international mark and in Cuba every year from 1973 until the present. From 1973 until 1995, more than 11 million boxes containing 12 bottles each have been sold thus amounting to more than 130 million bottles. Annual sales during this period have varied from a minimum of 2,689,596 bottles to more than 11.5 million bottles. These figures do not include sales of HAVANA CLUB rum in bulk which amounted to more than 85 million litres from 1984 to 1995. Attached hereto as Exhibit A is a compilation prepared under my supervision of sales figures of HAVANA CLUB rum in bottles for the years 1973-1995 as well as a summary of the total sales by country from 1972-August 1996. The information in this compilation was taken from annual compilations of sales figures which was the regular practice of Cubaexport and Havana Club International, S.A. to make in the ordinary course of the regularly conducted business activities of their companies.

Executed this 6th day of October, 1996 in *Paris*, France.



MARIA DE CARMEN ABARRATEGUI GOICOLEA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X
GALLEON S.A., : Cancellation No. 24,108
BACARDI-MARTINI U.S.A., INC., and :
BACARDI & COMPANY LIMITED, :
Petitioners, :
-against- :
HAVANA CLUB HOLDING, S.A. and :
HAVANA RUM & LIQUORS, S.A. d/b/a :
H.R.L., S.A., :
Respondents. :
Registration No. 1,031,651 :
-----X

CERTIFICATE OF EXPRESS MAILING AND SERVICE

I, Caroline Rule, Esq., hereby certify that the foregoing Declaration of Maria Del Carmen Abarrategui Goicolea in connection with the above-captioned cancellation proceeding is being deposited today, November 18th, 1996, with the United States Postal Service, utilizing the "Express Mail Post Office to Addressee" service, in an envelope addressed to the following:

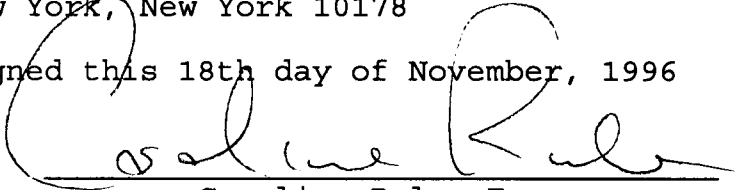
- 1) mailing label No. HB309362746 addressed to:

Box TTAB No Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

- 2) mailing label No. HB309361976, addressed to attorney for petitioner:

William R. Golden, Jr.
Kelley Drye & Warren
101 Park Avenue
New York, New York 10178

Signed this 18th day of November, 1996


Caroline Rule, Esq.



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LEONARD B. BOUDIN (1912-1989)
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*ADMITTED IN PENNSYLVANIA AND
NEW JERSEY ONLY

COUNSEL
VICTOR RABINOWITZ
MICHAEL B. STANDARD
LEONARD I. WEINGLASS
ELLEN J. WINNER
DEBRA EVENSON
TERRY GROSS

November 18, 1996

BY EXPRESS MAIL, Label No. HB309362746

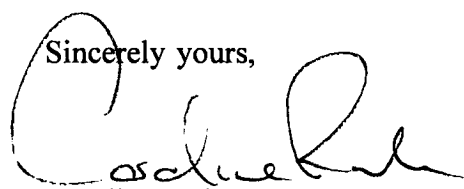
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TTAB No Fee
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: GALLEON, S.A. et al. V. HAVANA CLUB
HOLDING, S.A. et ano., Cancellation No. 24,108

Dear Sir/Madam:

Enclosed please find for filing the original and two copies of a Declaration of Maria Del Carmen Abarrategui Goicolea in connection with the above-referenced matter, along with a Certificate of Service of this document. A facsimile version of this declaration was previously filed with the Trademark Trial and Appeal Board as Declaration No. 3 attached to Respondents' Notice Of Motion For Summary Judgment and Declarations and Exhibits Submitted In Support Of Respondent's Motion For Summary Judgment, Volume I, which was filed on October 18, 1996. This original declaration should replace the prior facsimile version, which was filed because logistical problems prevented delivery of the original prior to the filing of Respondent's motion.

Sincerely yours,



Caroline Rule

cc. William R. Golden, Jr.
Margaret Ferguson
Kelley Drye & Warren
101 Park Avenue
New York, New York
Attorneys for Petitioners